REMARKS/ARGUMENTS

Claims 1-13 are pending in the instant application. The Examiner has issued a Requirement for Information under 35 C.F.R. §1.105 requesting the Applicant to identify "all co-pending applications and related patents . . . and identify the specific claims of those applications and/or patents which may present double patenting issues with the instant application claims." Claims 1, 2, and 5-11 stand rejected under 35 U.S.C. §102(e) as being anticipated by United States Patent No. 6,491,895 to Driehuys et al. Claims 3, 4, and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Driehuys as applied to claim 1 and further in view of United States Patent No. 5,245,282 to Mugler, III et al. The claims have been amended. Applicant respectfully submits that none of the amendments constitute new matter in contravention of 35 U.S.C. §132. Reconsideration is respectfully requested.

Requirement for Information

The Examiner has issued a Requirement for Information under 35 C.F.R. §1.105 requesting the Applicant to identify:

> **"all co-pending applications and related patents . . . and identify the specific claims of those applications and/or patents which may present double patenting issues with the instant application claims."**

Applicant respectfully submits that the Examiner's request is impermissible as being contrary to the express provisions of 37 C.F.R. §1.105. As expressly noted by MPEP 704.11:

> **"The terms factual" and "facts" are included in 37 CFR 1.105 to make it clear that it is facts and factual information, that are known to the applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that requirements under 37 CFR 1.105 are not requesting**

opinions that may be held or would be required to be formulated by applicant." (Emphasis added).

The Examiner's demand that Applicant identify claims that "may" present a double patenting issue is clearly beyond the bounds of what may be properly required under 37 C.F.R. §1.105 as it would require the Applicant to formulate an opinion, not merely provide additional "factual" information. As such, the Examiner's demand is improper. Withdrawal of this request is respectfully requested.

Nevertheless, Applicant submits contemporaneously herewith a supplemental Information Disclosure Statement including documents cited by a foreign examining authority within the past three months.

Section 102(e) Rejection

Claims 1, 2, and 5-11 stand rejected under 35 U.S.C. §102(e) as being anticipated by United States Patent No. 6,491,895 to Driehuys et al. This rejection is respectfully traversed.

Claim 1, as amended, recites a method of MR imaging using a hyperpolarized liquid MR imaging agent and wherein spectral-spatial excitation is used in combination with an FISP or PSFI pulse sequence with a flip angle of 45 to 90 degrees.

Driehuys, on the other hand, fails to disclose an FISP or PSFI pulse sequence with a flip angle of 45 to 90 degrees which is utilized in the MR imaging in combination with spectral spatial excitation. The sequences disclosed by Driehuys are single echo or multi-

echo pulse sequences (for instance col. 10, lines 22-24), specifically Echo Planar Imaging (EPI), Rapid Acquisition with Relaxation Enhancement (RARE), Fast Spin Echo (FSE), Gradient Recalled Echoes (GRE) and BEST (col. 14, lines 18-35).

As even acknowledged by the Examiner on page 5, item 5, none of the mentioned sequences describes a sequence protocol which is identical with a FISP or PSFI pulse. Therefore, as Driehuys fails to disclose each and every element of claim 1, Applicant respectfully submits that claim 1 is novel thereover. As the remainder of the claims are either directly or indirectly dependent on claim 1, Applicants respectfully submit that those claims have novelty over Driehuys as well. Reconsideration and withdrawal of the rejection are respectfully requested.

Section 103(a) Rejection

Claims 3, 4, and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Driehuys as applied to claim 1 and further in view of United States Patent No. 5,245,282 to Mugler, III et al. This rejection is respectfully traversed.

Applicant notes that the Driehuys reference was assigned to Medi-Physics, Inc., a wholly-owned subsidiary of Amersham, plc, (now GE Healthcare). At the time of the invention of the present invention, Applicant was under an obligation to assign all rights in the present invention to Amersham Health AS, also a wholly-owned subsidiary of Amersham, plc. As noted by the Examiner, the Driehuys reference is only available as prior art against the present invention under 35 U.S.C. §102(e).

35 U.S.C. §103(c) proviedes that

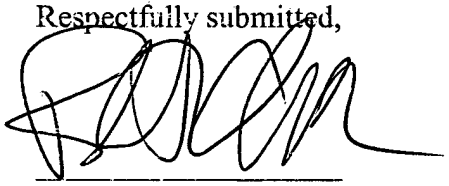
> **Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.** (emphasis added).

Therefore, as the Driehuys reference is only available as prior art under subsection (e) of Section 102, and as at the time the present invention was made, both the present invention and the Driehuys reference were under an obligation of assignment to the same person, the Driehuys reference may not preclude patentability of the present invention under 35 U.S.C. §103. Reconsideration and withdrawal of the rejection are respectfully requested.

In view of the amendments and remarks hereinabove, Applicant respectfully submits that the present application, including claims 1, 4-11, and 13-15, is in condition for allowance. Favorable action thereon is respectfully requested.

Any questions with respect to the foregoing may be directed to Applicant's undersigned counsel at the telephone number below.

Respectfully submitted,



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